

EGGERS -- 10/005,415  
Client/Matter: 083022-0278802

REMARKS

Applicant respectfully requests reconsideration of the present application based on the foregoing amendments and the following remarks. Applicants have amended claims 1, 14, 27, 41-46 and added claims 54-60. The claim amendments and additions are fully supported by the Specification and add no new matter. Upon entry of this amendment, claims 1-60 will be pending in the application.

*Objection To The Title*

In the Office Action the Examiner requires amendment of the title to more clearly indicate the claimed invention. Applicant has amended the title accordingly.

*Claim Rejections Under 35 U.S.C. 101*

In the Office Action, claims 41-45 stand rejected under 35 U.S.C. 101 as being allegedly directed to non-statutory matter. Applicants respectfully disagree. What is determinative is not how the computer performs the process, but what the computer does to achieve a practical application. MPEP 2106 citing *Arrhythmia Research Tech. v. Corazonix Corp.*, 958 F.2d 1053, 1057, 22 USPQ2d 1033, 1036 (Fed. Cir. 1992). Claims 41-45, as previously, recite process steps that achieve a practical application. Nevertheless, in the interest of furthering prosecution, Applicants have amended claims 41-45 to more clearly set forth the steps in said process. Applicants respectfully submit that the amendments render the §101 rejections moot and request withdrawal of the rejections.

*Claim Rejections Under 35 U.S.C. 112*

In the Office Action, claims 41-55 stand rejected under 35 U.S.C. 101 as being indefinite. Applicants respectfully disagree. First, the allegedly identified term "adapted to" appears only in previously presented independent claim 41 and is does not appear in independent 46 or claims 47-53 which depend from claim 46. Claims 54 and 55 were not present prior to this amendment. Thus Applicants submit that the rejections are limited to claims 41-45.

While applicants disagree with the Examiner's assessment of definiteness, Applicants have nevertheless amended claim 41. In amending the claim, Applicants have removed the term "adapted to" and submit that the rejections are therefore moot and should be withdrawn.

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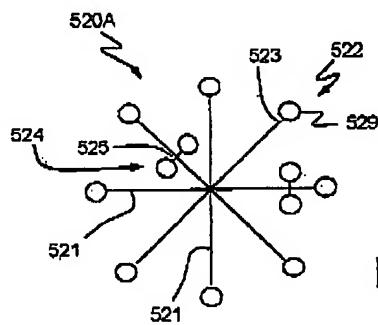
***Double-Patenting Rejections***

Applicants note that claims 1-53 are all rejected under the judicially created doctrine of obviousness-type double patenting. Applicants will file Terminal Disclaimers as appropriate upon indication that the claims include allowable matter.

***Claim Rejections Under 35 U.S.C. 102***

The Office Action maintains rejections of claims 1-53 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Application No. 10/613,434 of Milosavljevic et al. ("Milosavljevic"). Applicants respectfully traverse the rejections and provide the following responses and clarifications.

In the Office Action, the Examiner provides a definition of discrete as merely describing items that differ. Office Action 17(a) at page 4. Applicants respectfully disagree. As recited in the claims and as commonly used, the term "discrete" means "constituting a separate entity : individually distinct" or "consisting of distinct or unconnected elements." Merriam-Webster Online Dictionary at <http://www.m-w.com/dictionary/discrete>. With reference to Fig. 5A of the present Application (provided below), claims 1-45 require a plurality of discrete sample nodes 529 wherein each of said plurality of discrete sample nodes 529 carries a discrete sample. See Specification at page 32, lines 1-11. Even a cursory review of Figs. 5A-C confirms that the discrete sample nodes 529 and their discrete samples are described as claimed such that each discrete sample node is a separate entity (i.e. having well-defined, physically separated boundaries), individually distinct from the other discrete sample nodes and that each discrete sample also consists of distinct or unconnected elements.



**FIG. 5A**

However, Applicants have amended the claims and added claims 54-60 to more clearly set forth certain aspects of the claimed inventions and submit that the amended claims

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patentably define over the prior art. In amending the claims, Applicants have added limitations related to the structure and configuration of the claimed sample arrays and further emphasize the discrete nature of the sample nodes. The amendments add no new matter to the Application and are fully supported in the Specification including, for example, in Figs 5A-5C and in the written description at page 32, lines 1-28.

It is respectfully submitted that Milosavljevic does not teach every element of the amended claims. In particular, Milosavljevic does not teach, *inter alia*, a plurality of sample structures maintained in a predetermined spatial relationship with one another, each sample structure having an attachment point for removably attaching a corresponding discrete sample node. Additionally, Milosavljevic does not teach radial elements for maintaining a predetermined spatial relationship between a plurality of sample structures. Furthermore, the amended claims clearly distinguish the recited discrete sample nodes and discrete samples from Milosavljevic's DNA or RNA capture probes that differ from other probes in an array of test sites. See Milosavljevic at [0094]. Therefore, Applicants respectfully request withdrawal of the §102 rejections of claims 1-53 based on Milosavljevic.

***Claim Rejections Under 35 U.S.C. 103***

In the Office Action, alternative grounds of rejection are provided whereby claims 1-53 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Milosavljevic in view of U.S. Patent Application No. 10/617930 to Brignac et al ("Brignac"). Brignac does not cure the deficiencies of Milosavljevic. In particular, Brignac does not teach, *inter alia*, a plurality of sample structures maintained in a predetermined spatial relationship with one another, each sample structure having an attachment point for removably attaching a corresponding discrete sample node. Additionally, Brignac does not teach radial elements for maintaining a predetermined spatial relationship between a plurality of sample structures.

Instead, Brignac, as cited in the Office Action, is directed to a sample preparation system in which an "individual DNA biological sample is punched out of each DNA biological specimen and then robotically delivered, for example, to a multiwell tray" ([0018]). As described throughout Brignac, the biological specimen is provided on a flexible substrate (*see, e.g.*, [0018]).

Therefore, for at least these reasons, the §103 rejections of claims 1-53 should be withdrawn.

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***New Claims***

Claims 54-60 are new. Claims 54-60 introduce no new matter to the Application and are fully supported in the Specification and drawings.

***Conclusion***

All objections and rejections having been addressed, it is respectfully submitted that the present application is in a condition of allowance and a Notice to that effect is earnestly solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below. Please charge any fees associated with the submission of this paper to Deposit Account Number 033975. The Commissioner for Patents is also authorized to credit any over payments to the above-referenced Deposit Account.

Respectfully submitted,  
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